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10/25

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,926	02/04/2004	Zhili Xin	7041US02	3501
23492	7590	05/25/2005	EXAMINER	
ROBERT DEBERARDINE ABBOTT LABORATORIES 100 ABBOTT PARK ROAD DEPT. 377/AP6A ABBOTT PARK, IL 60064-6008			SACKY, EBENEZER O	
ART UNIT		PAPER NUMBER		1626
DATE MAILED: 05/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/771,926	XIN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	EBENEZER SACKEY	1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 22 February 2005.

2a)  This action is **FINAL**.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-19 is/are pending in the application.  
4a) Of the above claim(s) 15-19 is/are withdrawn from consideration.

5)  Claim(s) 6,10 and 13 is/are allowed.

6)  Claim(s) 2,11 and 14 is/are rejected.

7)  Claim(s) 3-5,7-9 and 12 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06/21/04.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_ .

**DETAILED ACTION**

**Status of Claims**

**Claims 1-19 are pending.**

**Claims 15-19 are withdrawn from consideration under 35 U.S.C 121 and 37 C.F.R. 1.142(b) as being drawn to non-elected subject matter.**

***Response to Restriction***

Applicant's election with traverse of Group II, claims 2-14 and species of Example 23, 5-(3-((1E)-3-hydroxy-2-(methoxycarbonyl)phenoxy)prop-1-enyl}phenyl)-4-(hydroxymethyl)isoxazole-3-carboxylic acid in the reply filed 02/22/05 is acknowledged.

However, because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

***Information Disclosure Statement***

The I.D.S. filed on 06/21/04 is acknowledged and has been entered into the file. A signed copy of the 1449 is attached herewith.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Substituent R<sub>3</sub> has been defined in claim 2. However, the substituent has not been depicted on structural formula (II), thus rendering the claim indefinite and vague.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Barret et al., Solid-Phase Synthesis of Isoxazoles Using Vinyl Ethers as Chameleon Catches, Organic Letters, Vol. 3, No. 20, pages 3165-3168 (2001).

Barret et al., discloses compounds of structural formula (II), which are identical to instantly claimed compounds and composition when R<sub>1</sub> is alkoxy, R<sub>2</sub> is hydrogen, each of R<sub>4</sub> and R<sub>5</sub> is hydrogen, L is a bond, and each of R<sub>6</sub> and R<sub>7</sub> is trihaloalkyl or R<sub>1</sub> is alkoxy, R<sub>2</sub> is hydrogen, each of R<sub>4</sub>, R<sub>5</sub>, and R<sub>6</sub> is hydrogen, L is a bond, and R<sub>7</sub> is a cyano group. See the reference at page 3167, compounds c and f.

***Allowable Subject Matter***

Claims 3-5, 7-9 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 6, 10 and 13 are allowed over the prior art of record.

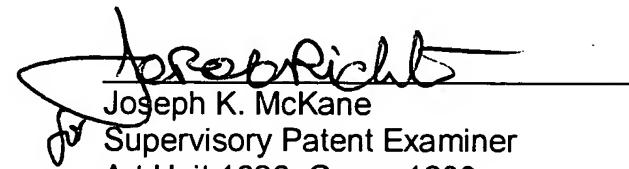
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (571) 272-0704. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

EOS  
May 19, 2005

  
Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626, Group 1600  
Technology Center 1